

U.S. Appl. No. 09/505,788  
Response to Office Action Mailed 12/12/02  
Page 90 of 93

### III. REMARKS

#### Present Application

Claims 1-4, 6, 11-14, 16, 20, 22, 23, 25-30, 33, 35-37, 39-45, 48, 50-52, and 54-56 have been pending in this application. Claims 57-74 have been newly added. No new matter has been introduced with this amendment which is supported throughout the instant Specification, especially on pages 84-97. Applicant respectfully asserts that all of the pending claims are now patentable.

#### Response to Rejections

##### 35 U.S.C. §112, Second Paragraph

##### The Examiner's Position

1. Claims 1, 10, 20, 22, 23, 39 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the Examiner's opinion, the following reasons apply:

- a) Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the definition of R<sup>2</sup>. There is no variable R<sup>2</sup> in Formula (I). It is believed that the applicants intended R<sup>2</sup>. (Claims 1, 22 and 23)
- b) Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by C<sub>1</sub>-C<sub>6</sub> alkyl, instead of the intended C<sub>1</sub>-C<sub>6</sub> alkyl. (Claims 1, 22 and 23)

U.S. Appl. No. 09/505,788  
Response to Office Action Mailed 12/12/02  
Page 91 of 93

c) Claim 10 is vague and indefinite in that it is not known what is meant by the definition of  $R^3$ , page 25 where the moieties have a box in the middle of each, i.e.  $CH_2C\Box CH$  and  $-CH_2C\Box C(CH_3)$ .

d) Claim 10 is vague and indefinite in that it is not known what is meant by the definition of  $R^5$  which includes the seven moieties in the last two lines of page 26 where the moieties have a box in the middle of each, i.e.  $-C\Box CH$ ,  $-CH_2C\Box CH$ ,  $-CH_2C\Box C(CH_3)$ ,  $-CH_2C\Box C(C_6H_5)$ ,  $-CH_2CH_2C\Box CH$ ,  $-CH_2CH_2C\Box C(CH_3)$  and  $-CH_2CH_2C\Box C(C_6H_5)$ .

e) Claim 10 is vague and indefinite in that it is not known what is meant by the definition of  $R^{10}$ . There is no variable  $R^{10}$  in the compounds of Formula (Ic).

f) Claim 10 recites the limitation " $=O$ " in the definition of  $R^{11}$ . There is allegedly insufficient antecedent basis for this limitation in the claim.

g) Claim 20 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the definition of  $R^{10}$ . There is no variable  $R^{10}$  in the compounds of Formula (Ic). (Claims 20, 39 and 54)

h) Claim 20 recites the limitation " $=O$ " in the definition of  $R^{11}$ . There is insufficient

U.S. Appl. No. 09/505,788  
Response to Office Action Mailed 12/12/02  
Page 92 of 93

antecedent basis for this limitation in the claim. (Claims 20, 39 and 54)

• **Double Patenting**

2. Claims 1-4, 6, 10-14, 16, 20, 22, 23, 25-30, 33, 35-37, 39-45, 48, 50-52 and 54-56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 14-18, 20, 22 and 24-26 of copending Application Serial No. 10/285,776. Although the conflicting claims are not identical, they are allegedly not patentably distinct from each other because the compounds, compositions and method of use of the compounds of formula I in copending Application No. 10/285,776 embraces the compounds, compositions and method of use of the compounds of Formula (I) as claimed herein. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**The Applicant's Response**

Applicant respectfully traverses the Examiner's 35 U.S.C. §112, second paragraph. Claims 1, 10, and 20 have been amended pursuant to the Examiner's suggestions. The rejections of the Claims 1, 10, and 20 and those Claims dependent therefrom under the statute are therefore deemed moot. In view of the present amendment, Applicant believes the pending claims in condition for allowance. Claims 57-73 have been added to further define the disclosed invention.

Applicant herewith submits an executed Terminal Disclaimer to obviate a provisional double patenting rejection over Applicant's co-pending Application Serial No. 10/285,776, bearing the signature of the responsible representative for the Applicant.

U.S. Appl. No. 09/505,788  
Response to Office Action Mailed 12/12/02  
Page 93 of 93

**CONCLUDING REMARKS, REQUESTS AND FEE PAYMENTS**

For all of the reasons set forth above, it is firmly believed that pending claims 1 - 4, 6, 10, 11-14, 16, 20, 22, 23, 25-30, 33, 35-37, 39-45, 48, 50-52, and 54-74 are allowable. Early notification of allowance is solicited.

**Fees**

The Commissioner is hereby authorized to charge payment of any fees that are required under 37 C.F.R. §1.16 in connection with the communication transmitted herewith, to Deposit Account No. 033-975.

Respectfully submitted,

Date: July 15, 2004



Hans-Peter G. Hoffmann, Ph.D.

Reg. No. 37,352

Agent for Applicant

Pillsbury Winthrop LLP

1600 Tysons Boulevard

McLean, VA 22102

(203) 965-8271